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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,407	03/19/2004	Shinsuke Ikishima	UNIU79.021AUS	7353

20995 7590 04/28/2009  
KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER
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DESAI, ANISH P

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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04/28/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/804,407	<b>Applicant(s)</b> IKISHIMA ET AL.	
	<b>Examiner</b> ANISH DESAI	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 03/10/09 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/10/09 has been entered.
2. Applicant has cancelled claim 17 and incorporated the subject matter of said claim in claim 21. Additionally, claim 21 includes newly added limitation "2-hydroxyethyl methacrylate or 2-hydroxyethyl acrylate, as monomer component". Support for the newly added limitation is found in the specification as originally filled.
3. The 35 USC Section 103(a) rejection based on Tomoko et al. (JP2001-232730, English translation provided by the Examiner) in view of Hiromasa Nomura et al. (article titled "High Durability Clear Painted Stainless Steel Sheets") to claims, 17, 18, 22, 29, and 30 are moot because these claims are cancelled. Further, neither Tomoko nor Hiromasa teaches or suggests "wherein the HALS-hybrid methacrylic or acrylic polymer comprises cyclohexyl methacrylate...**and 2-hydroxyethyl methacrylate or 2-hydroxyethyl acrylate**, as monomer components".
4. A new 35 USC Section 102(b) rejection based on Aoyama (JP 2003-053877-Machine Translation of abstract and "Detailed Description") is made.
5. A new 35 USC Section 112-first paragraph rejection is made.

***Specification***

6. The use of the trademark e.g. Adekastab LA-82 and LA-87 etc. (see page 9 lines 5-12 of the specification) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.
7. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
9. Claim 21 recites "wherein the methacrylic and/or acrylic polymers comprise a HALS-hybrid methacrylic or acrylic polymer". Specification does not provide support for the aforementioned recitation. While there is a support in the specification for to recite that the methacrylic and/or acrylic polymer(s) is or are HALS-hybrid methacrylic or

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acrylic polymer(s), there does not appear to be support for the presently claimed recitation. The presence of "comprise" broadens the scope of the claim given that the methacrylic or acrylic polymer(s) are now open to the inclusion of any additional polymers other than the HALS-hybrid for which there is no support in the specification as originally filled.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Aoyama (JP 2003-053877-Machine Translation of abstract and "Detailed Description").

11. Aoyama teaches a colored film (equated to Applicant's adhesive tape) comprising an elastic resin layer 4 (equated to Applicant's substrate), and a protective layer 2 that is formed on one side of the substrate (abstract). Further, the protective layer 2 of Aoyama is formed of same HALS-hybrid methacrylic and/or acrylic polymer as that of disclosed by Applicant in the specification (e.g. UV-G300 see 0057 of Aoyama). Further, Aoyama's teaching at 0022 and 0057 is interpreted to read on crosslinked protective layer. The protective layer of Aoyama is equated to Applicant's hard coating layer having a 3D-structure comprising methacrylic and/or acrylic polymers crosslinked with each other, wherein the methacrylic and/or acrylic polymer comprises a HALS-

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hybrid methacrylic or acrylic polymer, and wherein said HALS-hybrid methacrylic or acrylic polymer comprises cyclohexyl methacrylate or cyclohexyl acrylate and 2-hydroxyethyl methacrylate as monomer components. Moreover, Aoyama teaches a layer of adhesive 5 such as a pressure-sensitive adhesive that is formed on one surface of the elastic resin layer (substrate) (see abstract and 0036).

12. Additionally, the thickness of the elastic resin layer (substrate), protective layer (hard coating), and PSA layer of Aoyama is 5-300 micrometers (0034), 5-100 micrometers (0024), and 5-200 micrometers (0037) respectively. Further, the substrate of Aoyama is formed of polyolefin resin (see 0032).

**13.** Given that Aoyama's PSA tape and Applicant are identical in structure and/or composition, the presently claimed properties of the hydroxyl value and the swelling rate of no more than 5% are presumed to be inherent. Specifically, the PSA tape of Aoyama and Applicant are both formed of identical substrates, hard coating layer, and PSA. Further, the substrate, hard coating layer, and PSA of Aoyama and Applicant have same thickness. Moreover, the hard coating layer of Aoyama is crack-proof and has properties of water resistance, chemical resistance, and contamination resistance (0024). Accordingly, the aforementioned properties would be inherently present in the PSA tape of Aoyama. Thus, Aoyama anticipates the claimed invention.

### ***Response to Arguments***

14. Applicant's arguments filed on 03/10/09 have been fully considered but they are moot in view of the new ground(s) of rejection.

***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./  
Examiner, Art Unit 1794

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794